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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,591	06/08/2005	Sang Moon Lee	20020-03USA	5393

JHK Law
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EXAMINER

GOUGH, TIFFANY MAUREEN

ART UNIT	PAPER NUMBER
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1657

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01/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,591	Applicant(s) LEE, SANG MOON	
	Examiner TIFFANY M. GOUGH	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2008 has been entered. Claims 1 and 2 are pending and have been considered on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's invention of claim 1 is considered a product by process invention for which applicant is not enabled. Specifically, applicant clearly states throughout the specification that the **living** organism like the epidermis is influenced by electromagnetic radiation (see p.7), further explains the interactions, electrical and light, creating

Art Unit: 1657

oscillation energy (p.6) of the **living** organism tissue (p.7-1). Applicant clearly discloses a **living** organism, which is used and manufactured for detecting a bio-electromagnetic signal by using epidermal tissues of **living** organisms. However, applicant is claiming using epidermal tissue separated from a carcass of an organism. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention. Given the obvious differences between a living organism and a carcass and the functionalities of such, one of ordinary skill in the art would not expect to be able to use a dead, processed, epidermis to detect a bio-electromagnetic signal. Throughout applicant's specification applicant repeatedly refer to the epidermis as a solid living organism and further characterizes the epidermis of a "living" organism. Applicant continuously teaches the electric potential in "living" organisms. How is the epidermis of a dead animal a "living" organism? Further, applicant states on p. 5 of the reply filed 10/27/2008 that support for "cutting the epidermis to fit on the head of a probe" can be found at p. 23, lines 1-2. However, applicant teaches using a solid living bio-material on the head of a probe. Thus in view of the lack of any specific guidance with respect to the how a dead organism other than what is encompassed by the claims could possibly be used in such a method, one skilled in the art would expect a trial and error process to determine how a dead processed organism encompassed by the claims would apply to the as disclosed application, and would further have to determine through undue experimentation, without guidance from the specification, how to perform such detection using the epidermis of a dead animals carcass.

Undue experimentation would be required to practice the invention as claimed due to the quantity of experimentation necessary to manufacture a product for the detection of a bio-electromagnetic signal, limited amount of guidance and limited number of working examples in the specification because applicant only shows working examples of using the epidermis in soil as fertilizer; nature of the invention; state of the prior art; predictability or unpredictability in the art; and breadth of the claims. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment "...aromatic oil..." introduces new matter, which is not described in the specification as originally filed. Applicant teaches in the abstract and paragraphs 0058 and 0059 of the published application aromatics to be "(fragrances)". No where in applicants originally filed disclosure is there any teaching of aromatic "oil." Further support is admitted by applicant in the reply filed 10/27/2008 p.5, where applicant clearly states that "this recognition was not expressly indicated in the application as originally filed." Applicant argues that aromatics is consistent with aromatic oil or fragrances. While aromatic is consistent with fragrances, it certainly is not consistent with oils. The Merriam-Webster dictionary <http://www.merriam-webster.com/dictionary/aromatic> defines aromatic as "of,

Art Unit: 1657

relating to, or having aroma; fragrant; having a strong smell.” Clearly applicant does not have support for aromatic oil. Aromatic oil changes the scope of the claims and applicants invention for which no support is provided. **This is a new matter rejection.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maue (US 4762522).

Applicant claims a product by process comprising obtaining epidermis from a carcass of an animal (see claim 1).

Maue teaches the removal of skins/epidermis/hide from a carcass, soaking in a dichromate solution, i.e. pickling, which is known in the art to be performed in an acid, salt and water solution (col.1, lines 40-col.2 whole column, col. 7, lines 62-68), washing, drying, drum rotation (col.8-examples), exposing to ultraviolet light (col.11, lines 50-55), and oiling (col. 5, lines 1-30).

Maue does not teach cutting the epidermis of a fish, fowl or tortoise into required sizes, nor do they teach the specific temperatures and rpm.

However, at the time of the claimed invention, it would have been obvious to one of ordinary skill in the art to separate and obtain the epidermis from an animal, including fish, fowl, and tortoise given that the method of obtaining skin/hides is known in the art

Art Unit: 1657

for animal such as chickens, cattle, and deer, i.e. tanning processes. Further, cutting into required sizes is arbitrary, thus one could easily optimize the size as needed, as well as the temperatures and rpm. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In *re* Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 (“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”). See MPEP 2144.05

Moreover, at the time of the claimed invention, one of ordinary skill in the art would have been motivated to separate and obtain the epidermis from an animal, including fish, fowl, and tortoise with a reasonable expectation for successfully obtaining a bio-material because such a method is known in the art for obtaining skin/epidermis/hides from animals such as cattle, chickens, and deer, i.e. tanning processes. The patentability of a product does not depend on its method of production.

Art Unit: 1657

If the claimed product is the same or obvious from a product in the prior art (i.e. the product disclosed in the cited reference), the claim is unpatentable even though the reference product was made by a different process. When the prior art discloses a product which reasonably appears to be identical with or slightly different than the claimed product-by-process, rejections under 35 U.S.C 102 and/or 35 U.S.C 103 are proper. (MPEP 2113).

Response to Arguments

Applicant's arguments filed 10/27/2008 have been fully considered but they are not persuasive. Applicant argues that the art teaches a tanning method and that one of skill in the art would not consider Maue in respect to applicant's invention. Applicant argues that the method of Maue also comprises additional steps. Applicant is reminded that claim 1 is a "product by process" claim wherein the process is a open-ended in that the process recites "comprising". Further, the patentability of a product does not depend on its method of production. If the claimed product is the same or obvious from a product in the prior art (i.e. the product disclosed in the cited reference), the claim is unpatentable even though the reference product was made by a different process. When the prior art discloses a product which reasonably appears to be identical with or slightly different than the claimed product-by-process, rejections under 35 U.S.C 102 and/or 35 U.S.C 103 are proper. (MPEP 2113).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIFFANY M. GOUGH whose telephone number is (571)272-0697. The examiner can normally be reached on M-F 8-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1657

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ralph Gitomer/
Primary Examiner, Art Unit 1657

/Tiffany M Gough/
Examiner, Art Unit 1657